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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/974,624	10/09/2001	Alfred T. Tabayoyon JR.	SWIF 2123	8468
7812	7590	06/16/2006	EXAMINER	
SMITH-HILL AND BEDELL, P.C. 16100 NW CORNELL ROAD, SUITE 220 BEAVERTON, OR 97006			AVELLINO, JOSEPH E	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 06/16/2006

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/974,624  
Filing Date: October 09, 2001  
Appellant(s): TABAYOYON ET AL.

**MAILED**

**JUN 16 2006**

**Technology Center 2100**

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Daniel J. Bedell  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed May 22, 2006 appealing from the Office  
action mailed February 24, 2006.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

No amendment after final has been filed.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,360,254	Linden	3-2002
6,266,703	Clark et al.	6-2001
6,209,030	Ohashi	3-2001
6,237,099	Kurokawa	5-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1, 2, 4-8, 13-17, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan (USPN 6,789,108) in view of Wang et al. (USPN 6,314,454) (cited in prior actions as pertinent art) (hereinafter Wang).
2. Referring to claim 1, McMillan discloses a method for transmitting a document file describing a document from a sender computer 25 to a receiver computer 25 via a computer network 16 linking the sender computer and the receiver computer to a server computer 12-15, wherein the sender computer is operated by a sender, wherein the receiver computer is operated by a receiver, the method comprising the steps of:
  - a. transmitting the document file from the sender computer to the server computer via the computer network (Figure 10, 321; col. 8, lines 3-16);
  - b. transmitting the document file (i.e. email) from the server computer to the receiver computer via the computer network (Figure 11, 330; col. 8, lines 17-48);
  - c. providing viewer software (col. 3, lines 45-60; col. 4, lines 55-59) executed by the receiver computer for generating a display of an image of the document

(i.e. flash file or the like) described by the document file (i.e. email) when received by the receiver computer (col. 7, line 58 to col. 8, line 2), and for thereafter returning verification data to the server computer via the computer network verifying that the receiver computer has successfully displayed the document image (Figure 12, 340; col. 8, line 49 to col. 9, line 52).

McMillan does not specifically disclose that the receiver computer automatically returns verification data to the server computer. In analogous art, Wang discloses another method for transmitting a document file (i.e. email) which discloses automatically returning verification data to the server computer that the receiver computer has successfully displayed the document image (i.e. as shown in Figure 9, numerous actions by recipients are shown, including "opened" and a timestamp of the action, an inherent feature of opening an email is that it is successfully viewed, furthermore in order to reply or save an email it also must be viewed). It would have been obvious to one of ordinary skill in the art to combine the teaching of Wang with McMillan in order to allow the use of certified email messages in McMillan to allow the users to receive notification of the action taken upon the previously transmitted email messages by the recipients of the messages as supported by Wang (col. 3, lines 5-10).

3. Referring to claim 2, McMillan discloses further comprising the steps of:
  - d. storing log data (i.e. tracking software) on the server computer indicating when the receiver computer returned the verification data to the server computer (Figure 13, 410; col. 9, line 15-52); and

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- e. providing the sender computer with access to the log data via the computer network (col. 10, lines 38-54).
4. Referring to claim 4, McMillan discloses further comprising the steps of:
- d. transmitting a publish request from the sender computer to the server computer wherein the publish request identifies the receiver computer (col. 8, lines 3-16); and
  - e. prior to step b, transmitting an email message generated by the sender from the server computer to the receiver computer identified in the publish request, wherein the email message references the document file (col. 8, lines 3-16).
5. Referring to claim 5, McMillan discloses further comprising the steps of:
- f. prior to step e, storing the document file in the server computer and assigning a network address to the document file stored on the server computer (it is an inherent feature that whenever a file is stored onto a computer, it is assigned a unique file address, otherwise there will be no way in accessing the file) (col. 7, lines 3-27), wherein the email message transmitted at step e includes a reference to the assigned network address (col. 7, lines 59-67).

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6. Referring to claim 6, McMillan discloses the reference to the assigned network address is a hypertext link included in the email message (i.e. a standard email message) (col. 7, lines 59-67).

7. Claim 7 is rejected for similar reasons as stated above.

8. Referring to claim 8, McMillan discloses wherein step b comprises the sub-steps of:

- b1. verifying that the receiver is signed on to the server computer (i.e. password and username to the email account (Figure 13, 410; col. 9, lines 15-53, parameters i and j); and
- b2. thereafter transmitting the document file from the server computer to the receiver computer via the computer network (col. 8, lines 17-48).

9. Referring to claim 13, McMillan discloses the receiver computer returns the verification data to the server computer as an encoded network address (col. 9, lines 15-52).

10. Claims 14-17, and 21 are rejected for similar reasons as stated above.

Claims 9, 10, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan in view of Wang in view of Ohashi (USPN 6,209,030).

11. Referring to claim 9, McMillan discloses the invention substantively as described in claim 1. McMillan in view of Wang further discloses transmitting a publish request from the sender computer to the server computer, wherein the publish request identifies the receiver computer, and transmitting the document file from the sender computer to the server computer via the computer network (see claims above). McMillan in view of Wang does not specifically disclose the publish request indicated that the receiver computer is to be prevented from printing the document file. In analogous art, Ohashi discloses another method of transmitting document files from a sender to a receiver wherein the publish request (i.e. tag information) is that the receiver computer is to be prevented from printing the document file (e.g. abstract). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ohashi with McMillan and Wang since McMillan discloses that other encapsulation packages can be used (wherein the term "encapsulation" is taken as bundling the information for distribution in various entities) (col. 4, lines 45-48). This would lead one of ordinary skill in the art to search for other encapsulation means which would lead one to Ohashi and a secure encapsulation of HTML files such that hard copying of files is denied, thereby reducing the tendencies of unauthorized users obtaining classified or internal information as supported by Ohashi (col. 2, lines 10-18).

12. Referring to claim 10, McMillan in view of Wang discloses the invention substantively as described in claim 9. McMillan in view of Wang further discloses

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transmitting the document file from the server computer to the receiver computer via the computer network (see claim rejections above). McMillan in view of Wang does not specifically disclose preventing the receiver computer from printing the document file.

In analogous art, Ohashi discloses another method of transmitting document files from a sender to a receiver which prevents the receiver computer from printing the document file (e.g. abstract). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Ohashi with McMillan and Wang since McMillan discloses that other encapsulation packages can be used (col. 4, lines 45-48). This would lead one of ordinary skill in the art to search for other encapsulation means which would lead one to Ohashi and a secure encapsulation of HTML files such that hard copying of files is denied, thereby reducing the tendencies of unauthorized users obtaining classified or internal information as supported by Ohashi (col. 2, lines 10-18).

13. Claim 20 is rejected for similar reasons as stated above.

Claims 11, 12, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan in view of Wang in view of Kurokawa (USPN 6,237,099).

14. Referring to claim 11, McMillan in view of Wang discloses the invention substantively as described in claim 1. McMillan in view of Wang does not specifically disclose assigning a password to the document and transmitting the password to the

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server computer. In analogous art, Kurokawa discloses another method of transmitting document files from a sender to a receiver wherein the sender assigns a password to the document and transmitting the password to the server computer (Figure 3, 52, 53; col. 2, lines 15-23). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Kurokawa with McMillan and Wang in order to provide secure access to files and to prevent unauthorized access to documents, which is a well known security issue in computer networking.

15. Referring to claim 12, McMillan in view of Wang discloses the invention substantively as described in claim 1. McMillan in view of Wang does not specifically disclose providing a document password entry form to the receiver computer, entering a second password into the form to the server computer, and transmitting the document file from the server to the receiver when the second password matches the first password. In analogous art, Kurokawa discloses another method of transmitting document files from a sender to a receiver providing a document password entry form to the receiver computer, entering a second password into the form to the server computer, and transmitting the document file from the server to the receiver when the second password matches the first password (Figure 8, 90-95; col. 6, lines 31-58). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Kurokawa with McMillan and Wang in order to provide secure access to files and to prevent unauthorized access to documents, which is a well known security issue in computer networking.

16. Claims 18-19 are rejected for similar reasons as stated above.

Claims 3 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McMillan in view of Wang in view of Day et al. (USPN 6,243,722) (hereinafter Day).

17. Referring to claim 3, McMillan in view of Wang discloses the invention substantively as described in claim 1. McMillan in view of Wang does not specifically disclose transmitting a comment file containing comments generated by the receiver from the receiver computer to the server computer, storing the comment file on the server computer, and providing the sender computer with access to the comment file. In analogous art, Day discloses another method of transmitting document files from a sender to a receiver which transmits a comment file containing comments generated by the receiver from the receiver computer to the server computer, storing the comment file on the server computer, and providing the sender computer with access to the comment file (Figure 7, 150; Figure 8, 162; col. 8, line 5 to col. 9, line 24). It would be obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Day with McMillan and Wang in order to collectively develop and modify networked-based documents, thereby reducing production time and increasing feedback upon the document.

18. Claim 22 is rejected for similar reasons as stated above.

### **(10) Response to Argument**

Appellant's arguments found in the Brief have been fully considered but are not persuasive.

Appellant argues, in substance, that (1) the combination of McMillan, Clark, and Linden would not teach step f: sending verification data from the receiver computer to the server computer indicating that the receiver computer has successfully displayed the image of the document in the browser window (Brief, page 7, last paragraph), (2) Ohashi is merely directed to preventing a print screen operation, not the sending of a document file to a printer as specified in claim 9 (Brief, page 9), and (3) the combination of McMillan, Linden, Clark and Kurokawa does not teach step f of the claimed invention (Brief, page 12).

As to point (1) Appellant is incorrect. Appellant's attention is directed to Clark, col. 7, lines 43-50 where it is clearly stated that "the invention [of Clark] provides a method...for notifying an originator of an isochronous transmission with the recipient *has accessed a particular object* for a specified period of time. The mechanism...may be triggered by detecting accesses resulting from any process...such as a file access printing, **viewing**, or listening to an object" (emphasis added). This clearly shows that Clark can send confirmation back to a sender that a recipient has viewed a document

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(Clark: col. 5, line 67 to col. 6, line 16. The system of McMillan and Linden provide hypertext links in email (see rejection above) and would be beneficial to utilize the system of Clark with McMillan-Linden in order to ensure the senders of McMillan-Linden that the recipients have actually viewed the documents, rather than glancing at the email and not following the links to the documents. Furthermore the system of Clark would benefit from the addition of McMillan-Linden by only requiring the insertion of hyperlinks into the email rather than the entire document. This would reduce sending times and reduce bandwidth consumption, thereby reducing congestion on the network. Appellant provides one line of thinking as to what the combination of the references would create, however one of ordinary skill in the art would easily be able to combine the references in order to create the claimed invention as evidenced by the rejections above and the rationale provided in this response to argument. By this rationale, the rejection should be maintained.

As to point (2) Appellant is incorrect. Appellant's attention is directed to col. 5, lines 35-45 of Ohashi where it is stated that "if it is determined that an instruction to make a hard copy has been issued, then it is determined whether or not tag information indicating the prevention of a copy is included. If a copy is to be prevented, the process immediately terminates". The "tag information" is information contained in the HTML document (Figure 4; col. 4, lines 43-67). One of ordinary skill in the art would understand the statement "instruction to make a hard copy" as a "print" instruction, (for example clicking on the "print" icon in a browser), not necessarily a "print screen"

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instruction as Appellant has attributed it to mean. Appellant points to col. 2, lines 10-18 of Ohashi as teaching the prevention of carrying out a print screen operation, however this passage actually states "the user can easily make a hard copy of the information displayed by the browser". This does not disclose a "print screen operation" as Appellant has stated. One of ordinary skill in the art would clearly see this as a print operation of the entire file, since a print screen operation only grabs what is directly on the screen at the time (as Appellant has pointed out in the Brief, page 10). However, many times the document does not entirely fit on the screen (i.e. the use of scroll bars or "page down" buttons must be used. Users would want the entire document, not just what is shown on the screen. Furthermore, the tag information within the document indicates the copy prevention attributes, one of ordinary skill in the art that the system would prevent the document from being sent to the printer. By this rationale, the rejection should be maintained.

As to point (3), Appellant is advised to review the response to argument (1) where it is clearly stated how the combination of McMillan, Linden, and Clark teach step f. By this rationale, the rejection should be maintained.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

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For the above reasons, it is believed that the rejections should be sustained.

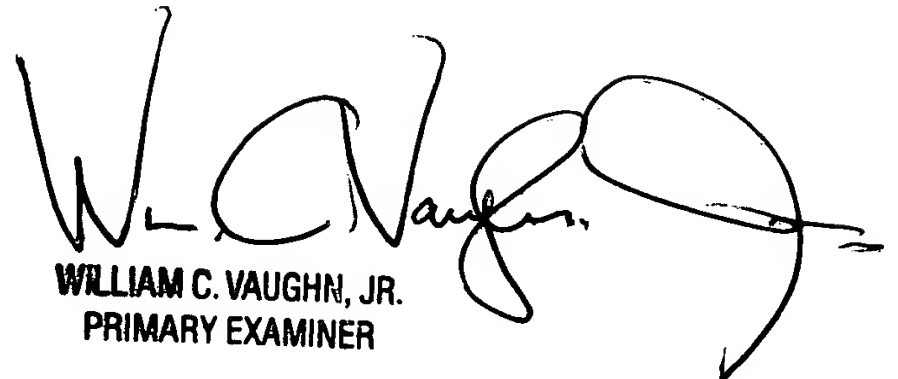
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